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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,727	04/08/2004	Philippe Jean Goix	076920-0851	3223
38706	7590	03/09/2007		
FOLEY & LARDNER LLP 1530 PAGE MILL ROAD PALO ALTO, CA 94304			EXAMINER WILLIAMS, DON J	
			ART UNIT	PAPER NUMBER
			2878	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/821,727

Applicant(s)

GOIX ET AL.

Examiner

Don Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments with respect to claim 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the reference numbers and figure have been manually written. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pettit (6,210,973).

As to claim 9, Pettit discloses tagged DNA fragments (16) are migrating down the gel (12) which constitutes causing the fluid to flow past a source of illumination (laser, 12) whereby the particles (DNA fragments, 16) emit fluorescent light (26) at one or more

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wavelengths, detector (46) periodically detecting the emitted characteristic fluorescence (light, 40, 42, 44) of particles (DNA fragment, 16) as the particles (DNA fragments, 16) flow through the illumination source (laser, 24), and providing output signals representative of the characteristic wavelength of each particles (DNA fragment, 16), (Abstract, fig. 1, column 8, lines 60-67, column 9, lines 1-23).

As to claim 10, Pettit discloses the characteristic fluorescence (light, 40, 42, 44) is detected by periodically passing the emitted light at each characteristic wavelengths (light, 40, 42, 44) through a filter (acousto-optic tunable filter, 34) and detecting (detector, 46) the passed emitted light (40, 42, 44), (fig. 1, column 8, lines 60-67, column 9, lines 1-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dovichi et al in view of Pettit (6,210,973).

As to claims 1, 4, 5, 7, Dovichi et al discloses a capillary (26), means (laser, 130) for projecting a light beam (132) through capillary (26) to illuminate a predetermined volume (fluid) in the capillary (26), means (pump, 110) for causing a sample containing sample particles (filaments, 126) which naturally fluoresce or are tagged (dyed) to fluoresce and emit light (132) at one or more distinct wavelengths to flow along the

capillary (26) through the predetermined volume (fluid), a spectral filter (139) for receiving light emitted by each particle, a detector (CCD Chip, 138) for detecting the output light, and a processor (computer, 142) configured to receive the output pulse signals representative of the amplitude of the fluorescent wavelengths, (see figure 1, figure 2, figure 11, column 3, lines 33-48, column 4, lines 62-67, column 5, lines 1-55).

Dovich et al fail to explicitly disclose a multicolor particle analyzer and a tunable filter.

Dovich et al does disclose that the spectrum of the transmitted light vary across the aperture of the filter since the transmitted spectrum depends on the incident light, (column 5, lines 53-56). This condition is indicative of a multicolor particle analyzer.

Dovich et al and Pettit are related fluorescent tagged detecting devices in that the fluorescent emissions can be measured at any number of wavelengths. Pettit discloses an acousto-optic tunable filter (34), (fig. 1, column 7, lines 64-67, column 8, lines 8-17).

The use of acousto-optical tunable filters is known in the art. It would have been obvious for one of ordinary skill in the art to modify Dovich et al to include the acousto-optic tunable filter as taught by Pettit in order to allow the passing of desired tagged pulses of fluorescence wavelengths which are detected and converted into electrical signals wherein the pulse outputs result in clear and precise images displayed on a monitor allowing critical and effective analyses to be performed.

As to claims 2, 8, the modified Dovich et al further disclose that Pettit (column 7, lines 64-65) sets forth an acousto-optic tunable filter (34) which constitutes that which is claimed.

As to claim 3, the modified Dovichi et al disclose a detector (CCD chip, 138) for detecting light scattered by particles (filaments, 126) as they travel through the predetermined volume (fluid), (column 5, lines 24-50).

As to claim 6, the modified Dovichi et al disclose a pump (110) that causes the particles (filaments, 126) to flow at a rate such that the light emitted by the particle (filaments, 126) is passed by the tunable filter a number of times as the particle (filaments, 126) transit through the analyzing region, (fig. 1, column 4, lines 62-67, column 5, lines 1-10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Don Williams whose telephone number is 571-272-8538. The examiner can normally be reached on 8:30a.m. to 5:30a.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Georgia Epps", is written in a cursive style.

Georgia Epps
Supervisory Patent Examiner
Technology Center 2800